

Remarks

Claims 1 – 38, 40 – 58, 60 and 61 remain in the application. Claims 39 and 59 are being canceled.

The amendments inserting the word "original" in claims 1, 22 and 42 are supported on page 9 lines 16-17 and on page 20 line 7 in the application as-filed.

Drawings

At the top of page 3 of the Office Action the Examiner noted that Applicants' new formal drawings were received on 5/17/06, but were not accepted because Figure 2 contained new matter in that item 211 was deleted and a non-original connection between item 214 and 216 was added.

In response Applicants are amending FIG. 2 to delete the non-original connection between item 214 and 216. Applicants respectfully traverse the requirement to restore the call-out number "211" which was not associated with anything in the FIG. 2 as-filed and which is not used in the Specification as-filed. Applicants are submitting herewith a new replacement FIG. 2.

Double Patenting

Next on page 3 and continuing through page 6 the Examiner rejected Claims 1, 22 and 42 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 12 and 15 of U.S. Patent No. 6,714,793. At the bottom of page 2 the Examiner noted that Applicants' Terminal Disclaimer (submitted on 9/26/06) was not accepted because it was not signed by an Attorney of Record. Applicants apologize for this oversight and are submitting herewith a new Terminal Disclaimer which is signed by an Attorney of Record.

Claim Rejections - 35 USC § 102

On page 7 the Examiner rejected claims 1-61 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,957,077 to Dehlin.

The Examiner alleged "[f]or claim 1, Dehlin teaches, a method of transmitting electronic messages in a computer environment, comprising the steps of: receiving an electronic message addressed to a telephone number; (Dehlin, col. 6 lines 12-27, cell phone)."

Applicants respectfully traverse. The cited passage only discusses generalities about SMS: "As an overview, Short Messaging Service (SMS) is a service that allows short text/data messages to be sent and received on Global System for Mobile Communications (GSM) cellular networks. Generally, there are three types of SMS messages..." (Dehlin col. 6 lines 14-18).

The present invention extends a cell phone text message (SMS) system to communicate with an instant messaging (IM) system.

In contrast, Dehlin oppositely extends an IM system to communicate with SMS devices. As Dehlin explains, "...based on an instant message transmitted by a sender" his "...invention creates a customized Short Message Service (SMS) message that is transmitted to a mobile device." (col. 2 lines 33-36, reordered)... cellular/pager network 380 delivers customized SMS messages 364 to and from mobile devices 320-322. The customized SMS messages 364 are created and processed by the IM/SMS translation application 362." (col. 5 lines 54-58)... "At block 504, an incoming IM message addressed to the alias (i.e., recipient alias) associated with the mobile device is received." (col. 6 lines 49-51). "At block 506, the incoming IM message is translated into a customized SMS message." (col. 6 lines 60-61).

Applicants' Response dated 4/4/07 pointed out that

Dehlin does not disclose or suggest "receiving an electronic message that is addressed **to a telephone number**." Instead, in Dehlin, the instant messages are addressed to an alias, which is not the telephone number of a mobile device, but instead an instant messaging screen name. (page 23, last paragraph).

The Examiner's Office Action dated 6/4/07 replied:

Applicant argues telephone number. A phone number is inherently present in the system of Dehlin, in order to receive a SMS message a phone number is necessary, and is used for addressing. (page 2, third paragraph).

Applicants agree that SMS messages are addressed to telephone numbers.

However, the original message received by Dehlin is not an SMS message, it is an Instant Message, and IM's are not addressed to telephone numbers. To make it explicit that in the present invention the message addressed to a telephone number is the original electronic message, Applicants are amending each of the independent claims 1, 22 and 42 to recite "original."

Dehlin says "the first computing device (i.e., the sender) is unaware that instant messaging is being performed with a mobile user. To the sender's perspective, instant messaging is being performed between two personal computers using a persistent Internet connection." (col. 7 lines 34-40, emphasis added). Thus, Dehlin does *not* teach "receiving an original electronic message addressed to a telephone number." (emphasis added). Dehlin receives an original electronic message addressed to an Instant Messaging device having an IM screen name alias which has been associated with a mobile device phone number by a user registering it (col. 6 lines 38-40). "...an incoming [original] IM message addressed to the alias (i.e., recipient alias) [not a telephone number] associated with the mobile device is received." (col. 6 lines 49-51). Then, "the incoming IM message is translated into a customized SMS message." (col. 6 lines 60-61).

Claim 1's second element, "determining an instant message identifier associated with the telephone number," is equated by the Examiner with "(Dehlin, col. 6 lines 35-47, alias, telephone number inherent to a phone)." Applicants respectfully submit that

the Examiner has it backwards. Dehlin starts with an instant message identifier and from that determines a (cell) telephone number associated with the instant message identifier.

For the claim 1 third element, "determining in real time whether an instant message receiver is currently available to receive messages addressed to the instant message identifier," the Examiner cited "(Dehlin, col. 5 lines 13-21, msn messenger, col. 7 lines 20-25, chat)." Applicants respectfully traverse. Dehlin does not inquire into "whether an instant message receiver is currently available...." Dehlin suggests that the receiver state is not effective: "[T]he instant messaging service maintains a list of aliases and their corresponding state in a database. The state corresponding to the alias for a mobile device will typically indicate offline. This offline state indicates to other IM aliases that the alias is not available for chatting. However, the instant messaging service allows an IM alias to send an IM message to an alias that appears offline." (Dehlin col. 6 lines 42-48).

As to the claim 1 element, "and performing a step from a group of steps consisting of: forwarding the electronic message as an instant message addressed to the instant message identifier in response to a determination that an instant message receiver is available to receive instant messages addressed to the instant message identifier" the Examiner cited "(Dehlin, col. 6 lines 35-60, alias status, computing device)." Applicants respectfully traverse. Dehlin says nothing about basing decisions on the availability of an IM receiver, or on the "state" of the alias. Specifically, even if the state is "on-line," Dehlin does not indicate whether the IM is passed on to the IM device as it would be without his invention.

As to the claim 1 element, "and sending the electronic message to a mobile device at the telephone number in response to a determination that no instant message receiver is available to receive instant messages addressed to the instant message identifier" the Examiner cited "(Dehlin, col. 6 lines 35-60, mobile device)." Applicants respectfully traverse. Not only does Dehlin say nothing about basing decisions on the

availability of an IM receiver, neither does he base decisions on whether the mobile device is turned on or off: "At block 508, the customized SMS message is sent to the mobile device. In overview, the mobile device is typically in a 'sleep' state unless actively engaged in some activity, such as a telephone call or using a Web browser. Even though the mobile device is in a 'sleep' state, the mobile device may accept and receive SMS messages. Thus, at block 510, the mobile device receives the customized SMS message." (Dehlin col. 7 lines 4-10).

The Examiner alleged "[f]or claim 2, Dehlin teaches, the method of claim 1, wherein the electronic message comprises any of: a text message, an SMS text message, an MMS message, a video message, and an audio message. (Dehlin, col. 5 lines 1-5, sms)." Applicants respectfully traverse. Neither in the cited passage nor elsewhere does Dehlin mention an MMS message, a video message, or an audio message.

The Examiner alleged "[f]or claim 4, Dehlin teaches, the method of claim 3, wherein the electronic device comprises any of: a computer, a personal data assistant (PDA), and a telephone receiver. (Dehlin, col. 6 lines 12-27, cell phone)." Applicants respectfully traverse. Claim 4 claims an instant message received at an electronic device which may be a telephone. The cited passages of Dehlin say nothing about instant messages; they discuss SMS text messages. Dehlin explains: "At block 508, the customized SMS message is sent to the mobile device." (col. 7 lines 4-5).

The Examiner alleged "[f]or claim 6, Dehlin teaches... determining whether or not to forward the electronic message as an email message addressed to an email address according to a user preference stored in a database. (Dehlin, col. 6 lines 35-45, "alias not available.')." Applicants respectfully traverse. Dehlin says nothing about forwarding messages as e-mails, much less according to a user preference.

The Examiner alleged "[f]or claim 7, Dehlin teaches... determining whether or not to forward the electronic message as an instant message addressed to the instant

message identifier according to a user preference stored in a database. (Dehlin, col. 5 lines 13-21)." Applicants respectfully traverse. Neither in the cited passage nor elsewhere does Dehlin mention storing user preferences in a database, much less whether or how to forward messages based on preferences.

The Examiner alleged "[f]or claim 8, Dehlin teaches, the method of claim 7, wherein the determining whether or not to forward is further based on source information of the electronic message. (Dehlin, col. 6 lines 35-60, database, col. 7 lines 4-15, sleep)." Applicants respectfully traverse. Neither in the cited passages nor elsewhere does Dehlin mention determining whether to forward an electronic message, much less based on source information of the electronic message.

The Examiner alleged "[f]or claim 9, Dehlin teaches, the method of claim 8, wherein the source information comprises any of: a source address of the electronic message, a user name of a sender of the electronic message, a telephone number of a sender of the electronic message, and an instant message identifier of a sender of the electronic message. (Dehlin, col. 6 lines 35-60, alias)." Applicants respectfully traverse. Dehlin does not base determinations on source information, much less on the claimed types of source information.

The Examiner alleged "[f]or claim 10, Dehlin teaches... the instant message is generated from the electronic message based on one or more predetermined rules. (Dehlin, col. 7 lines 20-30, message)." Applicants respectfully traverse. The instant message referred to in claim 10 is generated from an electronic message addressed to a cell phone number. The IM generated by Dehlin relays an SMS reply from the receiver cell phone, which is addressed to the sender's IM alias: "The reply customized SMS message identifies the sender and includes an IM message indicator in the message type field. An IM/SMS application receives the reply customized SMS message and translates the reply customized SMS message into a reply IM message at block 614." (Dehlin, col. 7 lines 54-59).

The Examiner alleged "[f]or claim 11, Dehlin teaches, the method of claim 10, wherein the one or more predetermined rules select one or more portions of the electronic message as the instant message. (Dehlin, col. 7 lines 47-52, sms mobile device)." Applicants respectfully traverse. Dehlin does not use predetermined rules to select portions to generate instant messages. The cited passage of Dehlin says simply "At block 610, the IM client creates a reply customized SMS message based on the sender information and input obtained above."

The Examiner alleged "[f]or claim 12, Dehlin teaches, the method of claim 10, wherein the one or more predetermined rules selectively delete one or more portions of the electronic message to generate the instant message. (Dehlin, col. 7 lines 47-52, sms mobile device)." Applicants respectfully traverse. Dehlin does not use predetermined rules to delete portions to generate instant messages.

The Examiner alleged "[f]or claim 13, Dehlin teaches... forwarding the electronic message to a storage medium. (Dehlin, col. 7 lines 41-46, reply)." Applicants respectfully traverse. Dehlin does not discuss forwarding messages to a storage medium.

The Examiner alleged "[f]or claim 14, Dehlin teaches... storing the electronic message in the storage medium. (Dehlin, col. 7 lines 32-40, computer)." Applicants respectfully traverse. Dehlin does not discuss storing messages in a storage medium.

The Examiner alleged "[f]or claim 15, Dehlin teaches... determining whether or not to forward the electronic message to the [sic, a] storage medium according to the user preference stored in the database. (Dehlin, col. 6 lines 35-60, database, col. 7 lines 4-15, sleep)." Applicants respectfully traverse. Dehlin col. 6 line 43 merely mentions a "database."

The Examiner alleged "[f]or claim 16, Dehlin teaches... forwarding the electronic message to the [sic, a] storage medium when the forwarding to the mail address and

the instant message identifier fails. (Dehlin, col. 6 lines 35-60, database, col. 7 lines 4-15, sleep)." Applicants respectfully traverse. This rejection is invalid for the same reason as the rejection of claim 15.

The Examiner alleged "[f]or claim 17, Dehlin teaches, the method of claim 15, wherein the determining whether or not to forward is further based on source information of the electronic message. (Dehlin,) col. 6 lines 35-60, database, col. 7 lines 4-15, sleep." Applicants respectfully traverse. This rejection is invalid for the same reason as the rejection of claim 15.

The Examiner alleged "[f]or claim 18, Dehlin teaches, the method of claim 15, wherein the user preference stored in the database comprises date and time preference of the instant message receiver. (Dehlin, col. 6 lines 35-45)." Applicants respectfully traverse. Dehlin does not mention a data or time preference.

The Examiner alleged "[f]or claim 19, Dehlin teaches... logging the forwarding the electronic message. (Dehlin, col. 7 line 66 to col. 8 line 11, sms)." Applicants respectfully traverse. Dehlin does not mention logging.

The Examiner alleged "[f]or claim 20, Dehlin teaches... blocking the forwarding of the electronic messages based on a list of telephone numbers. (Dehlin, col. 6 lines 35-60, alais)." Applicants respectfully traverse. Dehlin does not mention blocking forwarding of messages based on telephone numbers or elsewhere.

The Examiner alleged "[f]or claim 21, Dehlin teaches... the forwarding is based on the one or more predetermined rules. (Dehlin, col. 7 lines 47-55, customize)." Applicants respectfully traverse. The cited passage of Dehlin reads "At block 610, the IM client creates a reply customized SMS message based on the sender information and input obtained above," but does not teach forwarding based on predetermined rules.

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Claims 22-61 list the same elements of claims 1-21, relating to the same invention. Therefore, the supporting rationale of the rebuttals to the rejections to claims 1-21 applies equally well to claims 22-61.

Conclusion

Applicants respectfully request that the Examiner withdraw all objections and rejections, and issue a timely Notice of Allowance in this case.

Should the Examiner find it helpful, he or she is encouraged to contact the Applicants' attorney Michael A. Glenn at (650) 474-8400.

Respectfully submitted,



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